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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,899	02/15/2001	Shouichi Gotoh	MTS-3244US	6384

7590 09/10/2004

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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,899

Applicant(s)

GOTOH ET AL

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## FIRST ACTION REJECTION

### DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-42 are rejected under 35 U.S.C. §103( a ) as being obvious over Ebisawa 5,886,731 (3/23/1999) (herein referred to as ("Ebisawa").

As per independent claim 1, Ebisawa (the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41) discloses: *"The present invention relates to a video data receiving apparatus receiving video data, a video data transmitting apparatus transmitting video data broadcasting system distributing video data. . . . And the receiving state information data are stored by the external storing unit . . . for example, the floppy disk . . . with the user identification*

*code data which is added to the information and transmitted. . . . The storing unit 207 is a storage means for storing the program data stream and CM data stream inputted from the communication code decoder. . . .the storing unit . . . has a storage capacity enough to store 20 minutes worth of AV data. . . . AV data of 30 seconds each is inserted . . . As a result, the output AV data becomes as shown in FIG. 5B. Namely, the viewer views a Cm of 30 seconds every 30 minutes. . . . Note that, to enable such a reception, the storing unit 207 must have a storage capacity enough to store data of at least the amount of output of the CM. . . .”* The Examiner interprets this disclosure as showing: “An advertisement supplying method, characterized in that an area for recording advertisement data is created in a large-capacity recording medium located at a user’s location, advertisement data which are to be reproduced when an audience watch a program are recorded in said area in advance of the user watching the program, and said large-capacity recording medium is thereafter provided to the user, and after creating the advertisement data in the user’s large-capacity recording medium, selectively synthesizing the program watched by the user with portions of the advertisement data previously created and stored in the user’s large-capacity recording medium.”

Ebisawa lacks an explicit recitation of “a large-capacity recording medium located at a user’s location. . . .”, even though the cited disclosure of Ebisawa implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Ebisawa (the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll.

37-41) implicitly shows "a large-capacity recording medium located at a user's location. . . ." and it would have been obvious to modify and interpret the disclosure of Ebisawa cited above as showing "a large-capacity recording medium located at a user's location. . . .", because modification and interpretation of the cited disclosure of Ebisawa would have provided "*a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . .*" (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide "*a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . .*" (see Ebisawa (col. 1, ll. 50-55).

As per independent claim 2, Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41) implicitly shows all of the elements of claim 2.

Ebisawa lacks an explicit recitation of "a free area for recording advertisement data is created. . . ."

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41) implicitly shows "a free area for recording advertisement data is created. . . ." and it would have been obvious to modify and interpret the disclosure of

Ebisawa cited above as showing "a free area for recording advertisement data is created. . . .", because modification and interpretation of the cited disclosure of Ebisawa would have provided *"a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide *"a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 50-55).

As per claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37, Ebisawa shows the method of claim 1 and subsequent base claims depending from claim 1.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) implicitly shows all of the elements of claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37.

Ebisawa lacks an explicit recitation of some of the elements and limitations of claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37 even though the disclosure of Ebisawa implicitly shows same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32,

or 36 and 37 were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Ebisawa cited above as implicitly all the limitations of claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37, because modification and interpretation of the cited disclosure of Ebisawa would have provided *"a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide *"a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 50-55).

As per claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38, Ebisawa shows the method of claim 2 and subsequent base claims depending from claim 2.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) implicitly shows all of the elements of claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38.

Ebisawa lacks an explicit recitation of some of the elements and limitations of claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38 even though the disclosure of Ebisawa implicitly shows same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38 were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Ebisawa cited above as implicitly showing all of the elements and limitations of claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38, because modification and interpretation of the cited disclosure of Ebisawa would have provided *"a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide *"a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 50-55).

Independent claim 39 is rejected for substantially the same reasons as independent claim 1.

As per claims 40-42, Ebisawa shows the system of claim 39.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) implicitly shows all of the elements of claims 40-42.

Ebisawa lacks an explicit recitation of some of the elements and limitations of claims 40-42.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 40-42 were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Ebisawa cited above as implicitly showing all of the elements and limitations of claims 40-42, because modification and interpretation of the cited disclosure of Ebisawa would have provided "*a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . .*" (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide "*a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . .*" (see Ebisawa (col. 1, ll. 50-55).

## RESPONSE TO ARGUMENTS

3. Applicant's arguments (Amendment paper filed 8/9/2004) have been considered but are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection presented in this Office action.

### CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

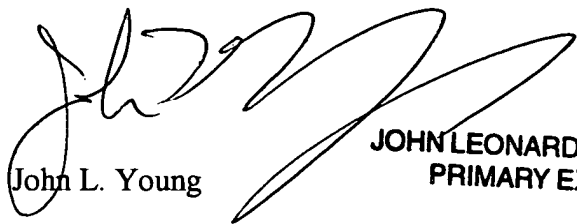
Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', is written over the printed name.

**JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER**

Primary Patent Examiner

September 5, 2004